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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/932,993 09/18/97 MCKAIN

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EXAMINER

WM01/0710

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ART UNIT

PAPER NUMBER

2612

DATE MAILED:

07/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/932,993

Applicant(s)
McKain et al.

Examiner
Andy Christensen

Art Unit
2612



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Apr 23, 2001

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1, 4-7, and 9-18 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1, 4-7, and 9-18 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 12

20) ☐ Other: _____

1. The Applicants' amendment filed April 23, 2001 has overcome the 35 USC 112 rejection of Claim 12.

2. The Applicants' arguments filed April 23, 2001 have been fully considered by the Examiner, but they are not deemed to be persuasive.

The Applicants argue that the only function described in Col. 8, lines 55-57 of Washino as being in the video camera is the storage-device-based digital recorder and does not say that the editing and production facility may be in the camera. However Col. 8, lines 55-57 of Washino specifically state that what is shown in Figure 3 may be employed in the video camera. Furthermore the Applicants admit that the elements of Fig.3 may be in a video camera (See Page 6, last paragraph, of the amendment.

The Applicants argue that the elements of Figure 4 of Washino are not in the video camera since it contains several elements additional to those of Figure 3. The Applicants further assert that Col. 9, line 39 says that Fig. 4 is for a production system.

In response, the elements shown in Figure 4 are said to be for a "production system", and are not described as requiring a production facility. Furthermore the wording of lines 39-40 clearly suggests that the system of Figure 4 is considered to be similar to that of Figure 3. There is no suggestion that the additional elements shown in Figure 4 preclude the same kind of application as that contemplated in Figure 3.

The Applicants argue that there is nothing in Washino to suggest that the structure described at Col. 12, lines 12-23 operates as two switches. The Examiner respectfully disagrees. The bus controller shown in Figure 4 operates so as to simultaneously receive both live camera and prerecorded inputs (Column 12, Line 20) and to output signals to two different devices 120, 124 (See Figure 4). Therefore it is clear that the bus controller operates as two switches, each able to receive both inputs and to output a specific signal to a selected device.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5, 6, 9-11 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the plurality of digital still images" in lines 13-14. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the plurality of digital still images" in lines 8-9. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the plurality of digital still images " in lines 2-3. There is

insufficient antecedent basis for this limitation in the claim.

In addition, Claim 18 is vague in that it is not clear which encoder is being recited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 1, 4-7 and 9-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Washino et al. (U.S. Patent No. 5,537,157).

Regarding Claim 1, Washino et al. disclose a digital motion picture recorder comprising a housing sized to be portable for use by an individual (Column 6, Lines 63-64; Column 8, Lines 55-56), a decoder mounted in the housing for receiving a full motion video signal and for converting the full motion video signal into a plurality of digital still images (Figure 2a; Items 50,52), a digital computer-readable and writeable random access medium (Figure 3, Item 70; Figure 4, Item 104) mounted in the housing and connected both to receive and store and to provide the plurality of digital still images in a computer-readable file format, an encoder mounted in the housing having an input for receiving a sequence of digital still images for generating as an output a full motion video signal (Column 10, Lines 11-18), a switch mounted in the housing having a first input receiving the plurality of digital images from the decoder and a second input receiving the plurality of digital still images from the digital computer-readable and writeable random-access medium and an output connected to the input of the encoder (See Column 12,

Lines 12-23 where such a switch is clearly present), an interface on the housing responsive to user input to cause the switch to provide one of the first and second inputs as the sequence of digital still images to the input of the encoder (See Column 8, Line 65 - Column 9, Line 9 with Column 12, Lines 12-23 and Column 14, Lines 35-53 where such an interface is clearly present), and a means for enabling a user to specify a sequence of segments of the plurality of digital still images stored on the digital, computer-readable and writable random-access medium, and to initiate playback of the sequence through the encoder (See Column 14, Lines 46-53 and note that a stored video program may be considered a sequence of segments of the still images since each stored still image of may be considered a segment, i.e. a frame, and a sequence of such segments constitute a program).

As to Claim 4, see Examiner's comments regarding Claim 1 and note that Washino et al. disclose a camera mounted on the portable housing having an output providing a video signal that is input to the decoder (Figure 2c).

As to Claim 5, see Examiner's comments regarding Claims 1 and 4.

As to Claim 6, see Examiner's comments regarding Claim 1.

Regarding Claim 7, Washino et al. disclose a means (Figure 3, Items 72, 74; Figure 4, Items 106, 110) for selectively operating the means for storing to store the received video signal

as digital video information or to direct stored video information to the encoder.

Regarding Claim 9, Washino et al. disclose a second encoder having a first input connected to receive stored digital video information and a second input connected to receive the received video signal, and an output providing an output video signal according to a selected one of the first and second inputs, and a means for causing the second encoder to select from one of the first and second inputs (See Figure 4 and note that encoders are supplied for each of a plurality of digital inputs).

Regarding Claim 10, Washino et al. disclose an audio encoder (Figure 4, Item 136) having a first input connected to receive input audio information and a second input connected to receive stored audio information, and an output providing an output audio signal according to a selected one of the first and second inputs, and a means for causing the audio encoder to select from one of the first and second inputs (Column 12, Lines 4-11).

Regarding Claim 11, Washino et al. disclose a first bus (Figure 4; "Digital Inputs") connecting the means for receiving the video signal to the first input of the encoder, and a second bus (Figure 4; "Data Bus") connecting the means for storing to the second input of the encoder (See also Column 12, Lines 15-21).

Regarding Claim 12, Washino et al. disclose a camera mounted on the portable housing having an output providing the full motion video signal (Figure 2c).

Regarding Claim 13, Washino et al. disclose a media data buffer (Figure 3; Item 72) which receives sequences of digital still images from the decoder and outputs the sequence of digital still images to the digital, computer readable and writeable random access medium and further comprising a processor (Figure 3; Item 74) for controlling data flow between the media data buffer and the computer readable medium.

Regarding Claim 14, Washino et al. disclose a first pixel bus (Figure 4; "Digital Inputs") for transmitting received sequences of digital still images from the decoder, and a second pixel bus (Figure 4; "Data Bus") for transmitting sequences of digital still images from the digital, computer readable and writeable random access medium wherein the first and second pixel buses are both connected to the switch (See Column 12, Lines 12-23 and Column 14, Lines 45-53 and note that such a connection is clearly present in order to provide an output consisting of images from either of the two sources).

Regarding Claim 15, Washino et al. disclose that the digital, computer-readable and writeable random access medium is a disk drive having a capacity to store several minutes of sequences of digital still images (Column 8, Lines 34-53).

Regarding Claim 16, Washino et al. disclose a means for receiving, digitizing and storing audio signals in synchronization with the motion video signals and for selecting audio from at least one of a plurality of audio channels (Column 12, Lines 4-11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino et al. in view of Morita (JP5-153448).

Regarding Claim 17, Washino et al. disclose a digital video recording device comprising a portable housing (Column 6, Lines 63-64; Column 8, Lines 55-56); a camera attached to the portable housing and having an output providing digital video information (Figures 2a and 3) ; a random access, computer-readable and writeable medium (Figure 3, Item 70; Figure 4, Item 104) mounted within the portable housing and connected to receive and store the digital video information from the camera; a first encoder (Figure 4; Item 124) mounted within the portable housing and providing output video information and having an input for receiving digital video information; a second encoder (Figure 4; Item 120) mounted within the portable housing and providing an output video signal to a display (Column 10, Lines 11-21); a first switch mounted within the portable housing and having a first input for receiving live digital video information from the camera and a second input for receiving recorded digital video information from the

random access computer-readable and writable medium, and an output connected to provide the digital video information to the input of the first encoder (See Column 12, Lines 12-23 where such a switch is clearly present); a second switch mounted within the portable housing and having a first input for receiving live digital video information from the camera and a second input for receiving recorded digital video information from the random access computer-readable and writeable medium, and an output connected to provide the digital video information to the input of the second encoder (See Column 12, Lines 12-23 where such a switch is clearly present); and an interface on the portable housing responsive to user input to enable the user to control the first switch and the second switch (See Column 14, Lines 35-53 where such an interface is clearly present).

Although it is clear that when the Washino et al. device is employed in a video camera (See Column 8, Lines 55-56) the display must be mounted on the portable housing, but the location of the display in Washino et al. is not specifically disclosed as being on the housing. However Morita shows both editing controls and a display on the housing of a camera/editing device (See Figures 2 and 4). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the display of Washino et al. on the housing in order to permit the performing of the editing operation in the video camera.

Regarding Claim 18, Washino et al. disclose a means for enabling a user to specify a sequence of segments of the plurality of digital still images stored on the digital, computer-

readable and writable random-access medium, and to initiate playback of the sequence through the encoder (See Column 14, Lines 46-53 and note that a stored video program may be considered a sequence of segments of the still images since each stored still image of may be considered a segment, i.e. a frame, and a sequence of such segments constitute a program).

6. Applicants' amendment necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any response to this final action should be mailed to:

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Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications; please mark "EXPEDITED PROCEDURE"; for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

8. Any inquiry regarding this communication or earlier communications from the examiner should be directed to Andy Christensen whose telephone number is (703) 308-9644.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Wendy


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Garber, can be reached on (703) 305-4929.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

ac
July 9, 2001



ANDREW B. CHRISTENSEN
PRIMARY EXAMINER